## *Remarks*

Reconsideration of this Application is respectfully requested.

Upon entry of the foregoing amendment, claims 25-82 are pending in the application, with claims 25, 33, 40, 54 and 68 being the independent claims. Claims 1-24 were previously cancelled.

Based on the following remarks, Applicants respectfully request that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn.

### *Claim Amendments*

At paragraph 2 of the Office Action, the Examiner noted that in the Second Preliminary Amendment filed on July 14, 2004, Applicants improperly labeled claims 25-39 with the parenthetical "(original)". Because claims 25-39 were added by way of a First Preliminary Amendment filed on April 2, 2004, Applicants should have labeled those claims with the parenthetical "(previously presented)". To address this issue, Applicants have provided a new listing of claims in this Reply that properly labels claims 25-39 as "(previously presented)". This claim listing is intended to replace all prior versions, and listings of claims in the application.

***Non-statutory Double Patenting Rejections***

The Examiner has rejected claims 25-82 based on the judicially created doctrine of non-statutory double patenting. In particular, on the basis of non-statutory double patenting, the Examiner has rejected:

- Claims 25-32 as being unpatentable over claims 1-18 of U.S. Patent No. 5,826,055 (Office Action at paragraphs 4 and 5), claims 1-10 of U.S. Patent No. 6,131,157 (Office Action at paragraph 9), and claims 1-11 and 32-41 of U.S. Patent No. 6,412,064 (Office Action at paragraphs 12 and 15);

- Claims 33-39 as being unpatentable over claims 11-34 of U.S. Patent No. 5,826,055 (Office Action at paragraphs 6-8), claims 11-28 of U.S. Patent No. 6,131,157 (Office Action at paragraphs 10 and 11), and claims 12-31 of U.S. Patent No. 6,412,064 (Office Action at paragraphs 13 and 14);

- Claims 40-53 as being unpatentable over claims 1-11, 23-34 and 41-47 of U.S. Patent No. 6,775,761 (Office Action at paragraphs 16, 19, and 22);

- Claims 54-67 as being unpatentable over claims 12-22 and 34-47 of U.S. Patent No. 6,775,761 (Office Action at paragraphs 18, 21, and 23); and

- Claims 68-82 as being unpatentable over claims 1-11 and 23-34 of U.S. Patent No. 6,775,761 (Office Action at paragraphs 17, 20).

Applicants have filed herewith a Terminal Disclaimer to Obviate a Double Patenting Rejection over each of U.S. Patent Nos. 5,826,055, 6,131,157, 6,412,064 and 6,775,761, thereby rendering these rejections moot. Accordingly, Applicants respectfully request that the double patenting rejections of claims 25-82 be reconsidered and withdrawn.

***Rejections under 35 U.S.C. § 102***

The Examiner has rejected claims 25-82 under 35 U.S.C. § 102(e) as being allegedly anticipated by commonly-owned U.S. Patent No. 5,961,629 to Nguyen *et al.* ("Nguyen" or "the Nguyen reference"). As set forth below, Applicants submit that

Nguyen is not prior art under 35 U.S.C. § 102(e) with respect to the currently pending claims because "one's own invention whatever the form of disclosure to the public, may not be prior art against oneself, absent a statutory bar." *In re Facius*, 408 F.2d 1397, 1406 (CCPA 1969).

First, Applicants note that the inventors in both the present application and the Nguyen reference were part of a project team at S-MOS Systems, Inc., that produced a new microprocessor architecture and subsequent chip implementation. This project team produced the microprocessor architecture that is described in the Nguyen reference. The Nguyen reference describes and claims in part a superscalar processing system having a plurality of stages, including a decoding and issuing stage and an execution stage.

As part of the microprocessor architecture project team, Applicants were responsible for the design and implementation of the Instruction Retirement Unit (IRU). The Applicants' IRU design is described generally in the Nguyen reference. The present application further describes the IRU initially disclosed in Nguyen in greater detail to support the invention as claimed in the present application. Thus, the IRU disclosed in the Nguyen reference was invented by Applicants rather than the inventive entity listed on the Nguyen reference. The supporting declarations filed herewith set forth the facts as detailed above.[1] Applicants submit that these declarations provide a "satisfactory showing which would lead to a reasonable conclusion" that Applicants are the inventors. *See* MPEP § 716.10 and *In re Katz*, 687 F.2d 450, 455, 215 USPQ 14, 18 (CCPA 1982).

---

[1] Filed herewith are true copies of original, signed declarations of Sanjiv Garg and Trevor A. Deosaran, which were filed in priority Application Serial No. 08/481,146 (now U.S. Patent No. 5,826,055) to overcome a like rejection under 35 U.S.C. § 102(e) over U.S. Patent No. 5,560,032 to Nguyen *et al.*, which shares a common specification with the presently-cited Nguyen reference, and in priority Application Serial No. 10/151,932 (now U.S. Patent No. 6,775,761) to overcome a like rejection over the Nguyen reference. All of the inventors are no longer employed by S-MOS Systems, Inc. The declaration of the remaining inventor, Johannes Wang, has not yet been returned.

For these reasons, Applicants submit that currently pending claims 25-82 are patentable over the Nguyen reference.

## *Conclusion*

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.

Thomas C. Fiala
Attorney for Applicants
Registration No. 43,610

Date: 1/13/05

1100 New York Avenue, N.W.
Washington, D.C. 20005-3934
(202) 371-2600